REMARKS

This amendment is submitted in response to the Office Action mailed April 5, 2007. No claims are amended herein, and claims 1-20 remain pending in the application. Applicants respectfully request reconsideration of the application and allowance of all pending claims in view of the above amendments and the following remarks.

Rejections Under 35 U.S.C. § 103

The Examiner rejected claims 16, 17, 18, 19, and 20 under 35 U.S.C § 103(a) as obvious in view of, and therefore unpatentable over, combinations of the following references: U.S. Patent Application Publication No. 2003/0212897 to Dickerson *et al.* (*"Dickerson"*) in view of official notice.

Applicants respectfully traverse the Examiner's rejections. To establish a *prima facie* case of obviousness, three criteria must be met: (1) the prior art references must teach or suggest all the claim limitations; (2) some suggestion or motivation to combine the references must be found in the prior art; and (3) there must be a reasonable expectation of success. MPEP § 2143. For at least the reasons explained below, Applicants respectfully submit that the Examiner has not established a *prima facie* case of obviousness.

Claim 16 was rejected as unpatentable over Dickerson in view of official notice. As amended, claim 16 recites a process combination including:

a processor to execute an operating system ("OS") and to execute a pre-boot application, the processor having a user mode and a kernel mode;

a hardware device communicatively coupled to the processor; and

a data storage unit communicatively coupled to the processor and having stored thereon a pre-boot environment module and a kernel proxy agent, the pre-boot environment module to be executed by the processor to generate an emulated pre-boot environment within the user mode for executing the pre-boot application and for passing requests for executing a desired task to the OS when the OS comprises a user mode application programming interface for executing the desired task, the kernel proxy agent to be executed by the processor to provide access to system resources to execute the desired task by enable enabling interaction between the pre-boot application and the hardware device when the OS does not include an OS user mode application programming interface ("API") for executing the desired task for interacting with the hardware device, wherein the kernel proxy agent comprises a software agent executing on the processor.

Dickerson is directed to a method and system for maintaining secure semiconductor device areas. The official notice is directed to accessing secure memory when the user is the supervisor. Dickerson and the official notice whether taken singularly or in combination, fail to disclose, teach, or fairly suggest at least one of the expressly recited limitations of amended claim 16, in particular, executing a pre-boot application within an emulated pre-boot environment, the emulated pre-boot environment "and for passing requests for executing a desired task to the OS when the OS comprises a user mode application programming interface for executing the desired task" and when "the OS does not include an OS user mode application programming interface ("API") for executing the desired task for interacting with the hardware device" using the kernel

proxy agent to [execute the desired task] by the processor to provide access to system resources."

Not only does Dickerson fail to disclose, teach or suggest every element and limitation of the claim, but Dickerson also teaches against a modification that would allow it to perform the recited process steps."

The office action admits on page 4 that "Therefore, any OS operating on Dickerson's processor can't have [a] user mode API to access 44. The only way to access 44 is through [a] kernel proxy agent." Claim 16 (as amended) instead allows access to system resources when an OS API exists and uses the kernel proxy agent when the OS API does not exist. Therefore, Dickerson does not anticipate claim 16. The office notice is also silent with respect to the claimed ways of accessing system resources.

Thus, Dickerson and the official notice, whether taken singularly or in combination, fail to disclose, teach, or fairly suggest at least one of the expressly recited limitations of claim 16. Accordingly, Applicants respectfully submit that claim 16 is not rendered obvious by the cited references. Amended independent claims 1 and 9 distinguish from the cited references for at least the same reasons as claim 1. Therefore Applicants respectfully request withdrawal of the rejection and allowance of the claims.

The dependent claims are novel and nonobvious over the prior art of record for at least the same reasons as discussed above in connection with their respective independent claims, in addition to adding further limitations of their own. Accordingly, Applicants respectfully request that the instant § 103 rejections of the dependent claims be withdrawn.

Claims 1-14 and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dickerson in view of US Patent Application 2001/0018721 to Lindeman ("Lindeman"). As mentioned above, Dickerson fails to disclose, teach or suggest every element and limitation of the claim. Applicants submit that Lindeman, at the very least, also fails to teach or suggest executing a pre-boot application as recited by the independent claims. Lindeman is instead directed towards to a method and apparatus for establishing a runtime open firmware environment from a boot-time open firmware image. Dependent claims are allowable at least for the reasons by which the independent claims are allowable.

Rejections Under 35 U.S.C. § 102

The Examiner rejected claims 1, 9 and 16 as anticipated under 35 U.S.C. § 102(e) by U.S. Patent No. 5,913,058 to Bonola ("*Bonola*"). Applicants respectfully traverse the Examiner's rejections. A claim is anticipated only if each and every element, as set forth in the claim, is found in a single prior-art reference. MPEP § 2131; *Verdegaal Bros. v. Union Oil of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). For at least the reasons explained below, *Bonola* cannot anticipate these claims because it does not disclose every element and limitation recited therein.

Claim 1,as amended, recites a process combination including:

executing a pre-boot application within an emulated pre-boot environment to test functionality of the pre-boot application, the emulated pre-boot environment executing within a user mode of a processor of a processing system during an operating system ("OS") runtime of the processing system and passing

requests for executing a desired task to the OS when the OS comprises a user
mode application programming interface for executing the desired task; and

interacting with a hardware device of the processing system in response to
the executing of the pre-boot application via a kernel proxy agent executing in a
kernel mode of the processor, wherein the kernel proxy agent comprises a
software agent executing on the processor to provide access to processing system
resources for executing the desired task by enable enabling interaction between
the pre-boot application and the hardware device when the OS does not include an
OS user mode application programming interface for executing the desired task.

Bonola merely discloses a system and method for using a real mode bios interface to read
physical disk sectors after the operating system has loaded and before the operating
system device drivers have loaded. The teachings of Bonola apply to a state wherein the
operating system has not been fully booted and thus cannot host an **emulation
environment** (as claimed). Thus Bonola is instead directed towards an OS **bootime**,
rather than an OS **runtime**. Bonola is directed towards speeding the boot process by
enabling simultaneous processing before the OS has completed booting (e.g., by loading
device drivers, which are used by the OS to expose APIs for the provided services).
Accordingly, independent claims are distinguished over the cited art.

Conclusion

Given the above amendments and accompanying remarks, all claims pending in
the application are in condition for allowance. If the undersigned attorney has
overlooked a teaching in any of the cited references that is relevant to allowance of the
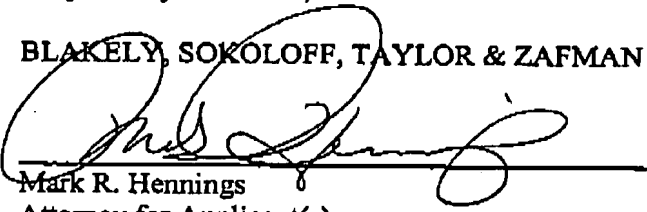claims, the Examiner is requested to specifically point out where such teaching may be

found. Further, if there are any informalities or questions that can be addressed via

telephone, the Examiner is encouraged to contact the undersigned attorney at (206) 292-

8600.

<u>Charge Deposit Account</u>

Please charge our Deposit Account No. 02-2666 for any additional fee(s) that may

be due in this matter, and please credit the same deposit account for any overpayment.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Date: 7/5/07

Mark R. Hennings
Attorney for Applicant(s)
Registration No. 48, 982

Blakely, Sokoloff, Taylor & Zafman LLP
12400 Wilshire Boulevard, Seventh Floor
Los Angeles CA 90025-1030
Phone: 206-292-8600
Facsimile: 206-292-8606

Enclosures: Postcard
                Amendment transmittal, in duplicate